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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/791,589      | 03/02/2004  | Glenn Klecker        | DBH:0756.0840       | 3452             |

152 7590 05/18/2005

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PORTLAND, OR 97204-3157

EXAMINER

HAMILTON, ISAAC N

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3724

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/791,589

Applicant(s)

KLECKER ET AL.

Examiner

Isaac N Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-27 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/02/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 3, 9, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 11, recites that the first handle is connected to the base of the jaw, then in claim 2, line 4, it is recited that the leg of the tang is aligned with the abutment face of the first handle; however, in claims 16 and 17 it is clearly shown that leg 128 of the tang 52 is aligned with the abutment face 130 of the second handle 34. For purposes of examination, the first handle is connected to the base of the jaw, and the second handle is connected to the tang.

Claim 9 recites the limitation "said cutting portion" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Berg et al (5,745,997), hereafter Berg. Berg discloses everything as noted in Diagram 1 below. Further note that the jaw is a bypass jaw and the cutter is a bypass jaw; the cutting tool is capable of

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being used as a pruning shear; folded position shown in figure 2; it is inherent that the sharpened cutter is removably mounted because the apparatus is held together by fasteners, and fasteners can be removed and refastened; channel 44, 52; side walls/base 244, 174, 228; supporting metal portion 174.

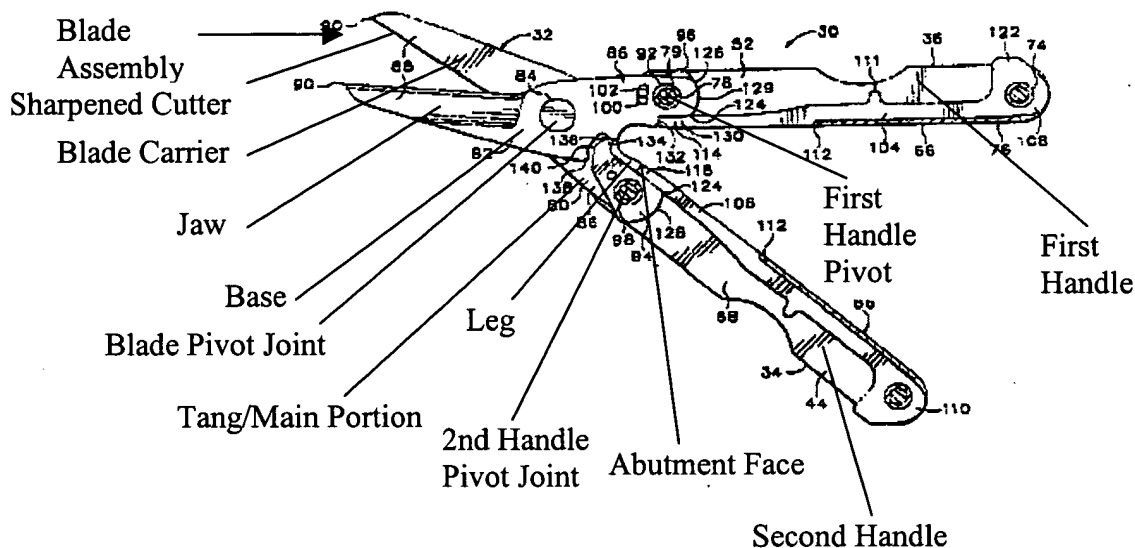


Diagram 1. Figure 9 of Berg is shown above in the extended, operative position.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, 7 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Montague et al (6,625,832), hereafter Montague, and Seber (5,528,834). Berg discloses everything as noted above, but does not disclose cushioning portions on the outer surfaces of the handles. However, Montague teaches cushioning portions 104 on the outer

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surfaces of the handles as shown in figure 1. It would have been obvious to provide cushioning portions on the outer surface of the handles in Berg as taught by Montague in order to provide extra gripping ability as well as a more comfortable fit in the user's hand. Berg does not disclose cushioning portions of elastomeric material, and does not disclose a molded shell layer of a rigid thermoplastic material. However, Seber teaches cushioning portions of elastomeric material 66, and molded shell layer of a rigid thermoplastic material 38. It would have been obvious to provide cushioning portions of elastomeric material, and a molded shell layer of a rigid thermoplastic material in Berg as taught by Seber so that a user can firmly grasp the apparatus. Note elongate margin is the outer surface of the side walls; outer margin/portion of an outer face is the surface area of the shell layer 38 in Seber.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Thompson et al (5,483,747), hereafter Thompson. Berg discloses everything as noted above, and discloses a fastener in column 5, lines 2-6. However, Berg does not disclose a tension screw and a locknut. However, Thompson teaches tension screw 51 and locknut 57. It would have been obvious to provide a tension screw and a locknut in Berg as taught by Thompson in order to remove the fastener with common household tools.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Seber (5,485,677). Berg discloses everything as noted above, but does not disclose a cutting portion with a hook portion and a sharpened edge in a throat portion. However, Seber teaches cutting portion 36, 52, 56 with a hook portion 36 and a sharpened edge 56 in a throat portion 52. It would have been obvious to provide a cutting portion with a hook portion and a sharpened

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edge in a throat portion in Berg as taught by Seber in order to increase the utility of the apparatus.

9. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Mizutani et al (2002/0124415A1), hereafter Mizutani. Berg discloses everything as noted above, but does not disclose a cavity including a spring with first and second opposite ends. However, Mizutani teaches cavity 5, 6 including spring 13 with first and second opposite ends 16. It would have been obvious to provide a cavity including a spring with first and second opposite ends in Berg as taught by Mizutani in order to increase the rate that the jaw and the sharpened cutter separate and increase overall cutting speed of the apparatus.

10. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Rausse (1,426,214). Berg discloses everything as noted above, but does not disclose a blade lock. However, Rausse teaches blade lock 21, 17, 18, 19, 16. It would have been obvious to provide a blade lock in Berg as taught by Rausse in order to slip the apparatus into a pocket while not in use. Note that the elements 21, 17, 18 and 19 may be provided on the end of the second handle; open position shown in figure 2; closed position in figure 1; when one of the handles is in the folded position, the blade lock in the engaged position shown in figure 1; lock pivot 23; shoulder 132 in Berg; catch body 19 in Rausse.

***Allowable Subject Matter***

11. Claims 17 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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12. Regarding the allowable subject matter, Berg discloses the invention substantially as claimed, but fails to disclose a leg that is parallel to the channel base. Prior art does not teach a leg that is parallel to the channel base.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH

May 12, 2005



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